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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,432	02/07/2001	Sidney Shaw White JR.	ESSI:012D1	6574

7590 09/23/2003
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12
EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/778,432

Applicant(s)

WHITE ET AL.

Examin r

Marc S. Zimmer

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-- Th MAILING DATE f this communicati n appears on the cover sheet with the correspondence address --
Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-30 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24,25,27-30,32,33 and 35 is/are rejected.
- 7) ☒ Claim(s) 26,34 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Based on a previous indication of allowable subject matter in claim 31, Applicant has amended claim 24 to include those patentable limitations. (The Examiner explained in paper no 4 that, although the Bier reference contemplated the utilization of a primer layer beneath the abrasion-resisting layer, no particular adhesion promoting compounds were reported. It was further stated that, while polysiloxane and polyacrylate primers are disclosed by the prior art, a specific motivation to employ one of these as the primer in Bier's invention had not been ascertained.)

In view of Applicant's amendment, a targeted search was initiated to determine whether the prior art did, in fact, provide a specific motivation to utilize one of the materials identified in original claim 31 as an underlayer. In the course of carrying out this search a new reference was discovered that enables the rejection of at least some of the remaining claims. The Examiner sincerely regrets any inconvenience to the Applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-25, 27-30, 32-33, and 35 are rejected under 35 U.S.C 103(a) as being unpatentable over Bier et al., U.S. Patent # 5,849,414 in view of Goosens, U.S. Patent # 4,207,357. As before, Bier anticipates every limitation of amended claim 24 except for the presence of a (meth)acrylic- or polysiloxane intermediate layer. It is nonetheless

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notable that Bier does contemplate the addition of a primer layer to the base substrate comprising polycarbonate prior to applying the abrasion resistant layer.

Goosens teaches that siloxane films (column 5, lines 29-59) similar to those disclosed by Bier do not always exhibit the degree of robust and uniform adhesion desired of them when placed over a polycarbonate-based substrate. It is, therefore, common practice to use primers to increase the strength of interaction between these materials. However, polycarbonates are easily attacked by many known primers or the solvent system required to deliver them (column 1, lines 44-48). Accordingly, Goosens sought alternative adhesion promoters that are not display bonding properties between polycarbonate and siloxane polymer but also is compatible with each. Their solution was to use an emulsion comprising a thermosetting acrylic (column 3, lines 34-68 through column 4, lines 1-27) and a hydroxy ether compound (column 4, lines 28-37) as a leveling agent (column 4, lines 46-49).

Please refer to paper no. 4 dated April 3, 2002 for a comprehensive discussion of how the dependent claim limitations are satisfied.

Allowable Subject Matter

Claims 26, 34, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There exist in the prior art innumerable references that disclose the utilization of acrylic primers in a similar capacity. See, for instance, Fujioika et al., U.S. Patent #

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4,405,679. Many of these had been discovered in previous searches conducted by the Examiner but they did not provide an clear incentive to select acrylics from the plethora of materials that are available as primers hence they could not be exploited in a statement of rejection under 35 U.S.C. 103. Rather, they only served to illustrate that the use of acrylics was known and, apparently, conventional for the purpose outlined above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

September 12, 2003



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700